

ARGUMENTS AND/OR REMARKS

In Paper No. 20070322, the Examiner objected to Figures 6-8 as not being labeled as “Prior Art” stating that “only that which is old is illustrated”, and referring to MPEP §608.02(g), which states:

“Figures showing the prior art are usually unnecessary and should be cancelled, Ex parte Elliott, 1904 C.D. 103; 109 O.G. 1337. However, where needed to understand applicant's invention, they may be retained if designated by a legend such as “Prior Art.”

If the prior art figure is not labeled, the following paragraph may be used.

Figures [1] should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 C.F.R. §1.121(d) are required in reply to the Office action to avoid abandonment of the application... The objection to the drawings will not be held in abeyance.”

Applicant has explained that Figures 6-8 are not “Prior Art”.

First, in Paper No. 20070322, the Office action dated 10 April 2007, the Examiner asserted that “Figures 6-8 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated” and cited §608.02(g) of the *Manual Patent Examining Procedure* (MPEP). The term “Prior Art” is defined by statute, not by the MPEP. Specifically, 35 U.S.C. §103(a) and (b) define the term “Prior Art” by reference to the several paragraphs of 35 U.S.C. §102. Nothing in any paragraph of §102, however, states that subject matter “which is *old*” constitutes prior art, as asserted by the Examiner in page 2 of the Office action, Paper No. 20070322. In short, the age of the subject matter does not convert that subject matter into prior art, as the term “prior art” is defined by the law of the United States. Consequently, the Examiner’s sole rational for imposing the requirement that

Figures 6-8 be labeled as “Prior Art” is contrary to statute and improper. The requirement must be therefore be withdrawn.

Second, Figures 6-8 are not themselves believed to constitute “Prior Art” as that term is defined by either 35 U.S.C. §102 or 35 U.S.C. §103. The Examiner has introduced no evidence into the record of this application which would either contradict Applicant’s belief or establish that Figures 6-8 constituted *prior art*, as that term is defined by 35 U.S.C. §103(a) of the statute, by its reference to §102 of the statute. As evidenced from the Declaration/Oath, the Applicant is a citizen of Republic of Korea, and, as such, devised Figures 6-8 in Korea in order to illustrate Applicant's discovery of problems that Applicant had discovery to have plagued the art. Therefore, since there is no showing that Figures 6-8 were known to anyone other than the Applicant *in this country* nor is there a showing that Figures 6-8 were *patented or published in this country or a foreign country* except when published, or laid-open, in Applicant’s Korean priority application Serial No. 10-2003-0018745 filed on 26 March 2003, then Figures 6-8 can not be deemed to be “Prior Art” absent evidence to the contrary.

Third, Figures 6-8 are simply abstract representations of the art prepared by the Applicant in an effort to illustrate Applicant's discovery of problems plagued in the art in accordance with 37 C.F.R. §1.83(b); this discovery is itself, together with Applicant's abstraction of the art represented by Figures 6-8, part of the Applicant's invention. By identifying deficiencies in the prior art and then addressing those deficiencies, Applicant completes the inventive process. As such, Applicant's effort

to identify deficiencies or other undesirable features in the art, does not constitute “Prior Art” as that term is used under 35 USC §103, and defined by 35 USC §§102(a)-(g).

Fourth, Applicant has never made any statement which could be construed as a declaration against interest or an admission that Figures 6-8 were “Prior Art”. If the Examiner is relying on the Applicant's use of the word “conventional” to mean “known by others in this country”, then the Examiner is incorrect. The present application is based on, and is a translation of, Korean Application Serial No. 10-2003-0018745, on which the Applicant has claimed priority as evidenced by the Declaration (Oath). Accordingly, the term “conventional” can, at most, only be considered with respect to Korea, not this country. MPEP §706.02(c) states, in part:

“The language “in this country” means in the United States only and does not include other WTO or NAFTA member countries.”

If the Examiner is relying on the Applicant's use of the word “conventional” to mean “patented or published in this country or a foreign country”, then the Examiner is again incorrect. There is no evidence that Figures 6-8 exist in any printed form other than in the present application and its priority document. There is evidence to indicate that Applicant devised the subject matter in Figures 6-8 however, and that evidence lies in the fact that the only existence of Figures 6-8 are in the present application and its parent priority document Korean Application Serial No. 10-2003-0018745 filed on 26 March 2003 and International Application No. PCT/KR04/000519 filed on 12 March 2004.

REMEDY REQUESTED

The Commissioner is respectfully requested to:

- A. Withdraw the requirement to label Figures 6-8 as "Prior Art";
- B. Return the prosecution history to the Examiner to reprove any assertion that Figures 6-8 should be identified as "Prior Art"; and
- C. Grant Applicant such other and further relief as justice may require.

Respectfully submitted,



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